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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/708,235

11/07/2000

Kevin Calloway

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08/16/2006

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,235

Applicant(s)

CALLOWAY ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 and 71-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 and 71-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 3/31/2006.
2. Claims 1-63 and 71-78 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-15, 18-33, 35-63 and 71-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibbeler (6,067,348 hereinafter Hibbeler) in view of Official Notice.**

With respect to claims 1-7, 9,-11, 55, 57, 58, 71-72, 74 Hibbeler teaches a system for creating and distributing a series of individualized multimedia messages over a computer network for a plurality of recipients (Abstract). A recipient information repository with unique recipient information for at least a first and second recipient (Figure 11, 300); a multimedia content repository with computer files comprising at least one of text and audio files (i.e. the greetings can be stored as text or audio and are converted into speech)(col. 5, lines 10-37); means for creating and delivering individualized multimedia content over said computer network to each of the plurality of recipients, wherein said multimedia content is assembled from selected elements with

the multimedia content repository which are selected in response to individual information about each of said recipients whose individual information is extracted from the recipient information repository (col. 3, lines 51-67).

With respect to the messages being graphic and video. Official notice is taken that it is old and well known to deliver messages in graphic and video format in order to provide a visual representation of the data received. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the messages being graphic or video in order to achieve the above mentioned advantage.

With respect to claims 20, 21, 24-30, 32, 49-50, 73 Hibbeler teaches a system for creating and distributing individualized multimedia messages over a computer network (Abstract). A computer operatively connected to said network and executing a programmed sequence of instructions (See Figure 11, 1110); a recipient information access routine with said programmed sequence of instructions which is capable of accessing data about a given intended recipient with unique recipient information for at least a first and second recipient (Figure 11, 300); a content repository containing multimedia elements that may be combined to form individualized messages with computer files comprising at least one of text and audio files (i.e. the greetings can be stored as text or audio and are converted into speech)(col. 5, lines 10-37); a content management routine within said programmed sequence of instructions which is capable of retrieving selected multimedia content from the content repository, wherein the process of selecting multimedia content is responsive to information content regarding

the given recipient accessed by the recipient information access routine (see Figure 11, 1110); a multimedia engine routine within said programmed sequence of instructions which packages the multimedia content as individualized message for delivery to the given recipient (Figure 11); a delivery routine within said programmed sequence of instructions which delivers the individualized message to the given recipient (Figure 11, 1120).

With respect to the messages being graphic and video. Official notice is taken that it is old and well known to deliver messages in graphic and video format in order to provide a visual representation of the data received. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the messages being graphic or video in order to achieve the above mentioned advantage

Claim 8 further recites a clean up routine which cleans up a recipient database by removing errors and unwanted redundancies. Official notice is taken that is old and well known in the computer related arts to remove errors and unwanted redundancies from a database in order to free memory space and to leave just useful information in the database. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a clean up routine which cleans up a recipient database by removing errors and unwanted redundancies in order to obtain the above mentioned advantage.

Claims 12-15, 33, 36-38, 54, 56, 59-63 further recite delivering the message via various e-mail formats. Hibbeler teaches transmitting the message over the Internet (col. 6, lines 38-40) therefore delivering messages via e-mail including various formats would have been obvious convenient and widely use by computer users.

Claims 19 and 23 further recite printing the individualized messages. Official notice is taken that is old and well known to print individualized messages to the customer in order to provide a more permanent output. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included printing the individualized messages in order to obtain the above mentioned advantage.

Claims 22 and 31 further recites known computer programming languages. Since Hibbeler teaches transmitting the message over the Internet (col. 6, lines 38-40) then it would have been obvious to have included the various programming languages.

Claims 39-40, 42-43, 45 further recite allowing direct client input and a search engine. Official notice is taken that is old and well known in computer related arts to allow direct client input in order to take the user's objectives, likes and dislikes into account for later customization of the data and a search engine for finding information . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included allowing direct client input and a search engine in order to obtain the above mentioned advantage.

Claims 41, 44 and 46 further recite restricting non-authorized parties from accessing a client campaign and files check in and out. Official notice is taken that is old and well known in the computer related arts to restrict non-authorized parties from accessing certain information and files check in and out. For example, certain employees would not have access to certain classified information for security reasons and keeping track of the files checked in and out to keep track of whoever is using those files. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included restricting non-authorized parties from accessing a client campaign and to manage file check in and out in order to achieve the above mentioned advantage.

Claim 47 further recites real time report and usage statistics. Official notice is taken that is old and well known in the computer related arts to real time reporting and usage statistics because such a modification would allow for collection, analysis and interpretation of the data collected.

Claim 51 further recites modifying the individualized message with an offer, rebate or discount. Official notice is taken that is old and well known in the computer related arts to offer an individualized, message or discount to a customer in order to increase the like hood that the customer will use the offer. For example, a couple with children will be given a children related offer that will take into account the customer

needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included modifying the individualized message with an offer, rebate or discount in order to obtain the above mentioned advantage.

Claim 52 further recites a word-of mouth form of advertisement. Official notice is taken that is old and well known in marketing to promote word-of mouth form of advertisement because such a modification would provide an inexpensive reliable form of advertisement.

Claim 53 further recites collecting user's recommendations. Official notice is taken that is old and well known to collect user's recommendations and input in order to use the information to improve and make modifications to the system in place. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included collecting user's recommendations in order to achieve the above mentioned advantage.

4. Claims 16-17, 34-35 and 75-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibbeler (6,067,348 hereinafter Hibbeler) in view of Smith et al. (6,725,381 hereinafter Smith).

Claims 16-17, 34 and 75-78 further recite sending a unique URL to the recipient pointing to the message content and a second routine to display the message content.

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Smith teaches on col. 4, lines 35-43, delivering a **personalized Universal resource locator (URL) in the e-mail message with instructions to the recipient to use the URL to retrieve the subject document** and allowing the user to click on the URL to open the content of the message . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Smith of sending a unique URL to the recipient pointing to the message content and displaying the message content because such a modification would allow for 'push' paradigm messaging and document delivery (col. 4, lines 35-43).

Response to Arguments

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., changing a message after broadcasting the message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if a system were to be claimed where the message is changed when sent, The Examiner wants to point out that Hibbeler teaches the greetings can be stored as text or audio and are converted into speech on col. 5, lines 10-37.

6. Applicant argues that in Hibbeler there is no way to produce multimedia over the telephone. The Examiner wants to point out that in Hibbler the greetings are stored as

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text or audio and are converted into speech on col. 5, lines 10-37 and therefore it would have been obvious to have included delivering the contents as text or audio as they are stored in order to avoid having to convert the information.

7. Applicant argues that Hibbeler doesn't teach changing the content based on personalized data, rather than simply adding data to the message. The Examiner wants to point out, that even if Hibbeler was just adding data to the message based on the individual's information, the content would be changed and customized based on the individual's information. In addition, on col. 5, lines 41-45, Hibbeler teaches **"The message body can be a single message or multiple messages that can be used to tailor the entire message to each individual recipient"**

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a second level of personalization) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if it was to be claimed, Hibbeler teaches on col. 5, lines 2-9, it further recites **"The personalized group message 800 is another alternative**

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embodiment comprised of a greeting segment 610, a group message 820, and a message body 620. The group message 820 includes a special message identifying the group and personalized toward the group as an additional personalization. An example is a personalized message from a CEO of a corporation, wherein the group message could identify a group such as the shareholders of the corporation, as in "Hi, Jim, as a shareholder of XYZ Corp., I want to tell you. . . ." In addition on col. 5, lines 43-45, Hibbeler teaches "the message body can be a single message or multiple messages that can be used to tailor the entire message to each individual recipient".

10. With respect to Applicant's arguments pertaining to the e-mail having a unique URL, the arguments are moot in view of the new ground of rejection in view of Smith. See above rejection.

11. In response to applicant's argument at the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

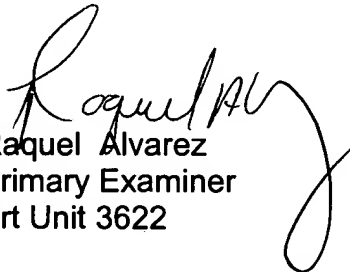
Point of contact

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
8/9/2006